

Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

Amendments to the Specification

The Specification has been amended to disclose BrainLAB AG and Image-Guided Neurologics Inc. as parties that have entered in a Joint Research Agreement.

Claim Rejections - 35 USC § 102 and § 103

Claims 1-16 and 18-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,549,803 (referred to as *Raghavan*) and/or under 35 U.S.C. § 103(a) as being unpatentable over *Raghavan* in view of U.S. Patent No. 6,272,370 (referred to as *Gillies*). Withdrawal of the rejections is respectfully requested for at least the following reasons.

Claims 1, 18 and 22 Are Novel over Raghavan

Amended claims 1 and 22 recite a method for planning the introduction of a fluid in a tissue, wherein the method includes using medical navigation to introduce an infusion device at a selected point. Claim 18 recites an apparatus that includes a medical planning and navigation system for assisting in positioning an infusion device.

As is well known by those having ordinary skill in the art, medical navigation refers to navigating an instrument in image space. A typical surgical application includes the display of patient medical images on a screen along with images of a medical instrument so as to assist the surgeon in guiding the instrument to a desired location on or in the patient.

As will be appreciated, a medical planning and navigation system is a system that enables medical navigation as described above.

Raghavan describes a system and method for modeling the movement of material in an organism. *Raghavan*, however, has not been found to teach or suggest the use of medical navigation within the framework of the invention described therein.

While *Raghavan* does refer to the use of "tracking", such tracking is in the context of monitoring the dispersion of a fluid within the organism from images of the organism. For example, *Raghavan* discloses that a fluid that is visible to a scan (as by MRI, sonogram, X-ray fluoroscopy, etc.) can be injected into the organism and its motion tracked. From the observed evolution of the fluid, coefficient values governing the fluid evolution can be derived and used within the model (col. 8, lns. 19-47). As

understood by one skilled in the art, monitoring the progression of a fluid in a body, without more, is not equivalent to medical navigation.

Accordingly, claims 1, 18 and 22 are novel over *Raghavan*.

Raghavan Is Removed as a Reference for Obviousness-type Rejections

In accordance with 35 U.S.C. § 103(c), *Raghavan* is removed as a reference for any rejections made under 35 U.S.C. § 103(a). Both *Raghavan* and the claimed invention were made by or on behalf of parties to a Joint Research Agreement (JRA) within the meaning of 35 U.S.C. § 103(c)(3) and 37 C.F.R. § 1.104(c)(4)(ii). Further, the JRA was in effect on or before the date the claimed invention was made, and the claimed invention was made as a result of activities undertaken within the scope of the agreement.

Accordingly, *Raghavan* cannot be combined with another reference to form an obviousness-type rejection.

In view of the above, withdrawal of the rejections of claims 1, 18 and 22 is respectfully requested. The remaining claims depend from one of the above claims and therefore, can be distinguished from the cited art for at least the same reasons.

Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

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